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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,235	12/20/2001	Mark S. Franke	KCC-16,491	9097
35844	7590	09/22/2004	EXAMINER	
PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD HOFFMAN ESTATES, IL 60195			STEPHENS, JACQUELINE F	
			ART UNIT	PAPER NUMBER
			3761	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/027,235	Applicant(s) FRANKE ET AL.	
	Examiner Jacqueline F Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 3-6, 15, 16 and 18-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7-14, 17, 34-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 6/1/04 have been fully considered and they are partially persuasive.

As to the rejection of claims 17, 44, and 45 as being anticipated by Heran USPN 4646362, applicant's arguments are persuasive.

2. As to the rejection of claims 1,2,7-14,17, and 34-52 under 35 U.S.C. § 103(a) as being unpatentable over Strohbeen et al. USPN 4610681 in view of Han WO 01/79602 applicant's arguments are not persuasive. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner has relied on Han for a teaching of a concealed seam, which Han teaches is which is aesthetically pleasing because the seam does not extend outwardly from the garment (Han page 8, lines 1-3). Strohbeen does not disclose a concealed seam, but Strohbeen teaches it a narrow, discrete seam is desirable to create a disposable garment having the appearance of underwear (col. 2,

lines 31-34). Because both references are concerned with minimizing the seam in a garment, it is reasonable to combine the teachings to arrive at a concealed seam.

3. In response to applicant's argument that Han teaches away from the present invention by teaching a method of sewing that results in a non-discrete fur fringe, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The examiner has relied on Han for the teaching of the concealed seam, which the offset seam is more accurately illustrated in Figures 8 and 9 of Han. The 'non-discrete' fur fringe is a product of the material used in the Han reference and would not be relevant to the materials used in Strohbeen or the present invention to make the disposable underpants.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 7-14, 17, and 34-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Strohbeen et al. USPN 4610681 in view of Han et al. WO 01/79602.

As to claim 1, Strohbeen discloses a disposable garment **10** comprising:

a front waist region, back waist region, and a crotch region extending between the waist regions (Figure 1),

a first side panel **11** extending from the front waist region;

a second side panel **12** extending from the back waist region;

a side seam **13** connecting an edge portion of the first side panel to an edge portion of the second side panel (Figure 1).

Strohbeen does not disclose the first side panel is offset with respect to the second side panel and the side seams comprise a primary and secondary bond.

Strohbeen discloses it is desirable to create a disposable garment having the appearance of underwear (col. 2, lines 31-34). For this reason, Strohbeen created a

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narrower or discrete exterior seam. However, the seam of Strohbeen extends outwardly from the garment and is visible (Figures 1 and 2). Han discloses a side seam connecting an edge portion **12** of the first side panel **11** to an edge portion of the second panel **19**, the first side panel offset with respect to the second side panel (Han Figures 8-9) for the benefit of providing a seam where the edge of the garment are covered by the fold and provide a garment, which is aesthetically pleasing because the seam does not extend outwardly from the garment (Han page 8, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the seam of Strohbeen to have offset panels and a fold for the benefits disclosed in Han.

As to claim 2 Strohbeen/Han discloses the panels are connected on their inner surfaces and a first seam (primary bond) is sewn, thus connecting an inner surface of the first side panel to an inner surface of the second side panel (Han page 8, lines 15-24; and Figure 9, where inner surfaces (sueded side) of panels are connected).

As to claim 7, Strohbeen/Han discloses the width of the fold (which corresponds to the width of the seam) is less than about 30 mm (Han page 8, lines 8-14).

As to claim 8, Strohbeen/Han discloses the width of the fold (which corresponds to the width of the seam) is about 5mm, which is included in the range of about 2mm to about 8mm (Han page 8, lines 8-14).

As to claims 9 and 11, Strohbeen/Han discloses the bonds have a width of 1/16-3/16" (1.58 - 4.76mm), which is included in the range of less than about 30 mm (Strohbeen col. 6, lines 25-29).

As to claims 10 and 12, Strohbeen/Han discloses the bonds have a width of 1/16-3/16" (1.58 - 4.76mm), which is included in the range of about 2mm to about 8mm (Strohbeen col. 6, lines 25-29).

As to claim 13, Strohbeen discloses a disposable garment **10** comprising a chassis comprising a front side panel **11** and a back side panel **12**, and defining a waist opening **15**, and first and second leg openings **14** (Figure 1);

a first side seam **13** extending from the waist opening to the first leg opening and connecting the front side panel and the back side panel;

a second side seam **13** extending from the waist opening to the second leg opening and connecting the front side panel and the back side panel (Figure 1).

Strohbeen does not disclose the first side panel is offset with respect to the second side panel and the side seams comprise a primary and secondary bond.

Strohbeen discloses it is desirable to create a disposable garment having the appearance of underwear (col. 2, lines 31-34). For this reason, Strohbeen created a narrower or discrete exterior seam. However, the seam of Strohbeen extends outwardly from the garment and is visible (Figures 1 and 2). Han discloses a side seam

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connecting an edge portion **12** of the first side panel **11** to an edge portion of the second panel **19**, the first side panel offset with respect to the second side panel (Han Figures 8-9) for the benefit of providing a seam where the edge of the garment are covered by the fold and provide a garment, which is aesthetically pleasing because the seam does not extend outwardly from the garment (Han page 8, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the seam of Strohbeen to have offset panels and a fold for the benefits disclosed in Han.

As to claim 14, Strohbeen/Han discloses the panels are connected on their inner surfaces and a first seam (primary bond) is sewn, thus connecting an inner surface of the first side panel to an inner surface of the second side panel (Han page 8, lines 15-24; and Figure 9 where inner surfaces (sueded side) of panels are connected).

As to claim 17, Strohbeen discloses a disposable garment **10** comprising:
a front waist region, back waist region, and a crotch region extending between the waist regions (Figure 1),

a first side panel **11** extending from the front waist region;

a second side panel **12** extending from the back waist region;

Strohbeen does not disclose a concealed side seam connecting an edge portion of the first side panel to an edge portion of the second side panel. Strohbeen discloses it is desirable to create a disposable garment having the appearance of underwear (col.

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2, lines 31-34). For this reason, Strohbeen created a narrower or discrete exterior seam. However, the seam of Strohbeen extends outwardly from the garment and is visible (Figures 1 and 2). Han discloses a side seam connecting an edge portion **12** of the first side panel **11** to an edge portion of the second panel **19**, the first side panel offset with respect to the second side panel (Han Figures 8-9) for the benefit of providing a seam where the edge of the garment are covered by the fold and provide a garment, which is aesthetically pleasing because the seam is concealed and does not extend outwardly from the garment (Han page 8, lines 1-3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the seam of Strohbeen to have offset panels and a fold to provide a concealed seam for the benefits disclosed in Han.

As to claim 34, Strohbeen/Han discloses the secondary bond, connects an outer surface of the second panel to the inner surface of the first side panel (Han, Figure 10).

As to claims 35 and 41, Strohbeen /Han discloses the width of the fold (which corresponds to the width of the seam) is less than about 30 mm (Han page 8, lines 8-14).

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As to claims 36 and 42, /Han discloses the width of the fold (which corresponds to the width of the seam) is about 5mm, which is included in the range of about 2mm to about 8mm (Han page 8, lines 8-14).

As to claims 37 and 39, Strohbeen/Han discloses the bonds have a width of 1/16-3/16" (1.58 - 4.76mm), which is included in the range of less than about 30 mm (Strohbeen col. 6, lines 25-29).

As to claims 38 and 40, Strohbeen/Han discloses the bonds have a width of 1/16-3/16" (1.58 - 4.76mm), which is included in the range of about 2mm to about 8mm (Strohbeen col. 6, lines 25-29).

As to claim 43, Strohbeen/Han discloses an inner surface of an edge portion of the front side panel is bonded to an outer surface of the back side panel (Han, Figure 10).

As to claim 44, Strohbeen /Han discloses the width of the fold (which corresponds to the width of the seam) is less than about 30 mm (Han page 8, lines 8-14).

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As to claim 45, Strohbeen/Han discloses the width of the fold(which corresponds to the width of the seam) is about 5mm, which is included in the range of about 2mm to about 8mm (Han page 8, lines 8-14).

As to claim 46, Strohbeen/Han discloses the concealed side seam comprises a primary bond and a secondary bond (Han Figure 9, elements 22' and 24', respectively).

As to claim 47, Strohbeen/Han discloses the primary bond connects an inner surface of the first side panel to an inner surface of the second side panel (Han, Figure 10).

As to claim 48, Strohbeen/Han discloses the secondary bond, connects an outer surface of the second panel to the inner surface of the first side panel (Han, Figure 10).

As to claims 49 and 51, Strohbeen/Han discloses the bonds have a width of 1/16-3/16" (1.58 - 4.76mm), which is included in the range of less than about 30 mm (Strohbeen col. 6, lines 25-29).

As to claims 50 and 52, Strohbeen/Han discloses the bonds have a width of 1/16-3/16" (1.58 - 4.76mm), which is included in the range of about 2mm to about 8mm (Strohbeen col. 6, lines 25-29).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

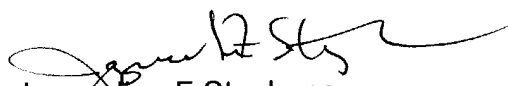
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (703)308-1412. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jacqueline F Stephens
Examiner
Art Unit 3761

September 18, 2004